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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,408	09/18/2003	Martin A. Voet	17455CIP1 (BOT)	7456

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EXAMINER	
KAM, CHIH MIN	
ART UNIT	**PAPER NUMBER**
1656	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/666,408	VOET, MARTIN A.	
	Examiner	Art Unit	
	Chih-Min Kam	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-12 and 14-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-12 and 14-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 10-12 and 14-20 are pending.

Applicants' response filed October 24, 2006 is acknowledged, and applicants' response has been fully considered. Thus, claims 10-12 and 14-20 are examined.

Withdrawn Informalities

2. Previous objection to the specification is withdrawn in view of applicant's amendment to the specification, and applicant's response at page 10 in the response filed October 24, 2006.

Maintained Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-12 and 14-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of treating fibromyalgia, the method comprising subcutaneously or intramuscularly administering a botulinum toxin to a patient with fibromyalgia, the botulinum toxin being administered at a first location, which is anatomically distinct from and/or anatomically distant from a second location at which second location the patient has fibromyalgia pain, wherein the first location and the second location are within a same dermatome, or wherein the first location and the second location are specified, does not reasonably provide enablement for a method of treating fibromyalgia, the method comprising subcutaneously or intramuscularly administering a botulinum toxin to a patient with fibromyalgia, the botulinum toxin being administered at a first location, which is anatomically

distinct from and/or anatomically distant from a second location at which second location the patient has fibromyalgia pain, where the first location is not identified. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claims 10-12 and 14-20 encompass a method of treating fibromyalgia, the method comprising subcutaneously or intramuscularly administering a botulinum toxin to a patient with fibromyalgia, the botulinum toxin being administered at a first location, which is anatomically distinct from and/or anatomically distant from a second location at which second location the patient has fibromyalgia pain. The specification, however, only discloses cursory conclusions without data supporting the findings, which state that a method of treating fibromyalgia comprising administering locally a clostridial neurotoxin to a peripheral location of a body of a patient afflicted with fibromyalgia, wherein the peripheral location is not a locus of pain, in one embodiment, a dermatome may include both the locus of pain and the site of administration; in another embodiment, the outline toxin being administered at a first location, which is anatomically distinct from and/or anatomically distant from a second location at which second location the patient has fibromyalgia pain (pages 10-12). There are no indicia that the present application enables the full scope in view of treating fibromyalgia as discussed in the stated rejection. The present application does not provide sufficient teaching/guidance as to how the full scope of the claims is enabled. The factors considered in determining whether undue experimentation is required, are summarized in In re Wands (858 F2d at 731,737, 8 USPQ2d at 1400,1404 (Fed. Cir.1988)). The factors most relevant to this rejection are the breadth of the claims, the absence or presence of working examples, the state of the prior art and relative skill

of those in the art, the predictability or unpredictability of the art, the nature of the art, the amount of direction or guidance presented, and the amount of experimentation necessary.

(1). The breadth of the claims:

The breadth of the claims is broad and encompasses unspecified variants regarding the site of administration (a first location), which is defined as the location that is anatomically distinct from and/or anatomically distant from a second location, and this first location can be any site that is functionally distinct from the second location. However, identification of a proper first location is not adequately described or demonstrated in the specification.

(2). The absence or presence of working examples:

Examples 1-8 indicate the treatment of patient with fibromyalgia by administering a botulinum toxin at a location which is within the same dermatome as the locus of pain; Example 9 indicates the injection of botulinum toxin is made within a dermatome that does not encompass the source of the pain; and Example 10 illustrates fibromyalgia pain can be treated by administration of botulinum toxin at a specific site which is anatomically distinct and anatomically distant from the location at which fibromyalgia pain is perceived.

(3). The state of the prior art and relative skill of those in the art:

While the related art (e.g., Paulsen *et al.*, Movement Disorders 11, 459 (1996), Childers *et al.*, J. Back & Musculoskeletal Rehabitation 10, 89-96 (1998)) indicates botulinum toxin is ineffective in treating fibromyalgia if the toxin was injected into the site of fibromyalgia associated pain, Asherson *et al.* (J. Rheumatology 28, 1740 (2001)) indicates injection of botulinum toxin A into fibromyalgia trigger points offer prolonged relief without any discernible side effects in a pilot study. However, the general knowledge and level of the skill in the art do

not supplement the omitted description, the specification needs to provide specific guidance on the site of administration which is anatomically distinct and anatomically distant from the location at which fibromyalgia pain is perceived.

(4). Predictability or unpredictability of the art:

The claims encompass a method of treating fibromyalgia comprising subcutaneously or intramuscularly administering a botulinum toxin to a patient with fibromyalgia, the botulinum toxin being administered at a first location, which is anatomically distinct from and/or anatomically distant from a second location at which second location the patient has fibromyalgia pain. While the specification teaches patients with fibromyalgia can be effectively treated by administering botulinum toxin at a location (first location) which is within the same dermatome as the locus of pain, it does not sufficiently describe identification of a proper first location because the first location can be any site that is anatomically distinct from and/or anatomically distant from a second location (i.e., the locus of pain), e.g., if the fibromyalgia pain is located in the leg (second location), the first location can be in the head, neck, shoulder, arm, lower back, hip, or chest, so which site is the proper first location for administration of botulinum toxin that provides effective treatment.

(5). The amount of direction or guidance presented and the quantity of experimentation necessary:

Claims 10-12 and 14-20 are directed to a method of treating fibromyalgia comprising subcutaneously or intramuscularly administering a botulinum toxin to a patient with fibromyalgia, the botulinum toxin being administered at a first location, which is anatomically distinct from and/or anatomically distant from a second location at which second location the

patient has fibromyalgia pain. The specification has indicated the treatment of patient with fibromyalgia by administering a botulinum toxin at a location which is within the same dermatome as the locus of pain (Examples 1-8); and Example 10 indicates fibromyalgia pain can be treated by administration of botulinum toxin at a specific site which is anatomically distinct and anatomically distant from the location at which fibromyalgia pain is perceived. However, the specification does not describe the first location can be any site that is anatomically distinct from and/or anatomically distant from a second location (i.e., the locus of pain), where the effective treatment of fibromyalgia can be reached. For example, if the fibromyalgia pain is located in the leg (the second location), the head, neck, shoulder, arm, lower back, hip and chest, which are anatomically distinct from and/or anatomically distant from a second location of leg, can all be the first locations, thus which site is the proper first location for administration of botulinum toxin that provides effective treatment. Since the specification does not provide sufficient teachings on the identification of the proper first location for administration, it is necessary to carry out undue experimentation to identify the location of administration (a first location) that can provide effective treatment of fibromyalgia.

(6). Nature of the Invention

The scope of the claims encompasses a method of treating fibromyalgia by administering a botulinum toxin at a first location that is anatomically distinct from and/or anatomically distant from a second location (i.e., the locus of pain), but the specification does not provide sufficient teachings on the site of administration that can produce effective treatment of fibromyalgia. Thus, the disclosure is not enabling for the reasons discussed above.

In summary, the scope of the claim is broad, while the working example does not demonstrate the claimed variants, and the teachings in the specification are limited, therefore, it is necessary to carry out further experimentation to identify the location of administration and to assess the effect of botulinum toxin in the treatment of fibromyalgia.

Response to Arguments

Applicants indicate scope of claims 10-12 and 14-20 are fully enabled by the specification, and one of ordinary skill in the art would be able to practice the claimed methods for treating fibromyalgia, without undue experimentation. As disclosed in the specification, the first location can be "anatomically distinct from and/or anatomically distant from a second location" (page 12, lines 19-20). Additionally, many examples of distances between the location of botulinum administration (first location) and fibromyalgia pain (second location) are provided in the specification (see at page 20, lines 6-21). In addition, the instant specification provides an example (Example 10, pages 29-30) where fibromyalgia pains located at a particular location (second location) are alleviated due to botulinum toxin administration at an anatomically distinct and distant location (first location), where fibromyalgia pains in the lower back (second location) are alleviated by administration of botulinum toxin into the shoulders (first location), an anatomically distinct and distant location. There is no requirement that the instant specification provide specific, exact examples of all the combinations of first locations (botulinum administration), second locations (fibromyalgia pain), and distances therebetween, that can be treated in accordance with the teachings of the present disclosure and scope of the claims. The absence of particular variants/examples does not render the instant written description inadequate to support claimed methods for treating fibromyalgia at a second location that is anatomically

distinct and/or distant from a site where a botulinum toxin is administered (first location) (see attached Falker-Gunter Falkner v. Inglis (Fed. Cir. 2006, 05-1324) 79 USPQ2d 1001, 1007). Thus, a person of ordinary skill in the art, clearly familiar with basic human anatomy, would clearly comprehend the meaning of the claim limitations of first and second locations being at anatomical locations that are distinct and/or distant from one another, and the specification enables the practice of the claimed invention, without undue experimentation (pages 4-7 of the response).

Applicants' response has been fully considered, however, the arguments are not found persuasive because of the following reasons. While the specification discloses the first location can be "anatomically distinct from and/or anatomically distant from a second location" (page 12, lines 19-20), and provides an example (Example 10, pages 29-30) where fibromyalgia pains located at a particular location (second location) are alleviated due to botulinum toxin administration at an anatomically distinct and distant location (first location), the specification does not teach how to identify a proper first location for administration from many locations that are anatomically distinct from and/or anatomically distant from a second location. As indicated above, e.g., if the fibromyalgia pain is located in the leg (the second location), the head, neck, shoulder, arm, lower back, hip and chest, which are anatomically distinct from and/or anatomically distant from a second location of leg, can all be the first locations, which site is the proper first location for administration of botulinum toxin that provides effective treatment, thus, it requires undue experimentation to identify the proper first location for administration. Falker-Gunter Falkner v. Inglis (Fed. Cir. 2006, 05-1324) 79 USPQ2d 1001, 1007) indicates examples are not necessary to support adequacy of written description, provided patent specification

otherwise provides sufficient information to convince person of ordinary skill in art that inventor possessed claimed invention, however, the instant specification does not provide sufficient information regarding identification of the proper first location for administration. One Example (Example 10, pages 29-30) does not provide sufficient information on the identification of the proper first location for administration from many sites that are anatomically distinct from and/or anatomically distant from a second location. Thus, the full scope of the claims are not enabled.

Maintained Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-12 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-12 and 14-20 are indefinite as to where is the first location for administering a botulinum toxin since the claim recites the first location is anatomically distinct from and/or anatomically distant from a second location at which second location the patient has fibromyalgia pain, and there are many locations meet the limitaion of the first location, e.g., if the fibromyalgia pain is located in the leg (the second location), the head, neck, shoulder, arm, lower back, hip and chest all can be the first location, thus it is not clear where the first location is, and what is the distance between the first location and the second location. Claims 11, 12, 14-16, 18 and 19 are included in the rejection because they are dependent on a rejected claim and do not correct the deficiency of the claim from which they depend.

Response to Arguments

Applicants indicate the specification clearly directs a practitioner of the claimed methods to where the first location can be. As disclosed in the instant application, the first location is (a) located relative to the second location at which a fibromyalgia pain present itself, and (b) must be at a location that is "anatomically distinct from and/or anatomically distant from a second location.", which is the location of the pain (page 12, lines 19-20), which is understood by one of ordinary skill in the art familiar with basic human anatomy (page 8 of the response).

Applicants' response has been fully considered, however, the arguments are not found persuasive because there are many locations that are anatomically distinct from and/or anatomically distant from a second location, e.g., if the fibromyalgia pain is located in the leg (the second location), the head, neck, shoulder, arm, lower back, hip and chest all can be the first location, so which site is the proper first location for administration.

Conclusion

5. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Primary Patent Examiner

CHIH-MIN KAM
PRIMARY EXAMINER

CMK
December 30, 2006